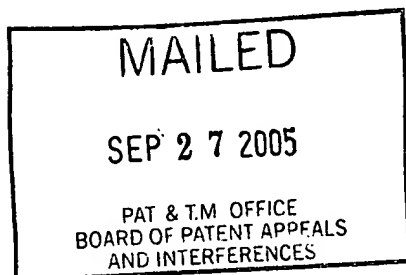




## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Judge Michael P. Tierney  
Telephone: 571-272-9797  
Facsimile: 571-273-0042



Applicants: GIERSET  
Application No. [REDACTED] 08-335461  
Filed: 11/07/94  
For: Enhancing the sensitivity of tumor cells  
to therapies

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,377.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

/ss/ Michael P. Tierney  
MICHAEL P. TIERNEY  
Administrative Patent Judge

Mail Stop Interference  
P.O. Box 1450  
Alexandria Va 22313-1450  
Tel: 571-272-9797  
Fax: 571-273-0042

Paper 1

Filed 27 September 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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RUTH A. **GIERSET** and ROBERT E. SOBOL,  
Junior Party  
(U.S. Application No. 08/335,461),

v.

JACK A. **ROTH**, TOSHIYOSHI FUJIWARA,  
ELIZABETH A. GRIMM, TAPAS MUKHOPADHYAY,  
WEI-WEI ZHANG and LAURIE B. OWEN-SCHAUB,  
Senior Party  
(U.S. Patent No. 5,747,469).

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Patent Interference No. 105,377  
(Technology Center 1600)

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**DECLARATION - Bd.R. 203(d)**

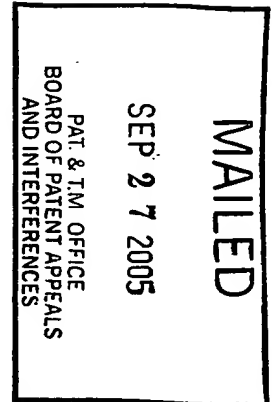
Before Michael P. Tierney, Administrative Patent Judge.<sup>1</sup>

**Part A. Declaration of interference**

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or as not corresponding to the

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<sup>1</sup>As part of Board efforts under the Government Paperwork Elimination Act, signatures on papers originating from the Board are being phased out in favor of a completely electronic record. Consequently, in this case papers originating at the Board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 C.F.R. § 10.18.



count(s) appear in Parts E and F of this DECLARATION.

**Part B. Judge managing the interference**

Administrative Patent Judge Michael P. Tierney has been designated to manage the interference. 37 CFR § 41.104(a) [Bd. R. 104(a)].

**Part C. Standing order**

A Trial Section STANDING ORDER [SO] accompanies this DECLARATION. The STANDING ORDER applies to this interference.

**Part D. Initial conference call**

A telephone conference call to discuss the interference is set for **2:00 p.m. on November 15, 2005** (the Board will initiate the call).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile (SO ¶ 4.5) a list of the motions (Bd. R. 120; Bd. R. 204; SO ¶ 26) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a shorter or longer period.

A copy of default times for taking action during the preliminary motion phase of the interference accompanies the NOTICE DECLARING INTERFERENCE. Counsel should be prepared to justify altering the default times.

The Board is conducting an electronic filing and a DVD pilot project. Copies of the procedures are attached to this order. Counsel should be prepared to discuss participation in the electronic filing pilot project.

**Part E. Identification and order of the parties**

Junior Party

Named Inventors:	RUTH A. GIERSET, SAN DIEGO, CA ROBERT E. SOBOL, RANCHO SANTA FE, CA
Application:	08/335,461, filed November 7, 1994
Title:	ENHANCING THE SENSITIVITY OF TUMOR CELLS TO THERAPIES
Assignee:	SIDNEY KIMMEL CANCER CENTER
Accorded Benefit:	U.S. Application No. 08/248,814, filed May 24, 1994, now Abandoned  U.S. Application No. 08/236,221, filed April 29, 1994, now Abandoned

Senior Party

Named Inventors: JACK A. ROTH, HOUSTON TX  
TOSHIYOSHI FUJIWARA, OKAYAMA JP  
ELIZABETH A. GRIMM, HOUSTON TX  
TAPAS MUKHOPADHYAY, HOUSTON TX  
WEI-WEI ZHANG, HOUSTON TX  
LAURIE B. OWEN-SCHAUB, HOUSTON TX

Patent: U.S. Patent No. 5,747,469, issued May 5, 1998, based  
upon U.S. Application No. 08/233,002, filed April 24, 1994

Title: METHODS AND COMPOSITIONS COMPRISING DNA  
DAMAGING AGENTS AND P53

Assignee: BOARD OF REGENTS, THE UNIVERSITY OF TEXAS  
SYSTEM

Accorded Benefit: NONE<sup>2</sup>

The senior party is assigned exhibit numbers 1001-1999. The junior party is assigned exhibit numbers 2001-2999. Bd. R. 154(c)(1). The senior party is responsible for initiating settlement discussions. SO ¶ 18.

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<sup>2</sup>The involved Roth et al., U.S. Patent No. 5,747,469 claims 35 U.S.C. §120 benefit of the following:

- (i) continuation-in-part of U.S. Application 08/145,826, filed October 29, 1993 (now U.S. Patent 6,410,010),
- (ii) which is a continuation-in-part of U.S. Application 07/960,513, filed October 13, 1992 (now U.S. Patent 6,017,524),
- (iii) which is a continuation-in-part of U.S. Application 07/665,538, filed March 6, 1991, now abandoned.

Should Roth believe that it is entitled to priority benefit of one or more of these applications, Roth should include in its motion list a motion requesting an earlier benefit date and be prepared to discuss its proposed motion during the initial conference call.

**Part F. Count and claims of the parties**

**Count 1**

Claim 1 of U.S. Patent No. 5,747,469.

The claims of the parties are:

Roth, U.S. Patent No. 5,747,469:	1-105
Gierset, U.S. Application No. 08/335,461:	1, 2, 4-20 and 23

The claims of the parties which correspond to Count 1 are:

Roth, U.S. Patent No. 5,747,469:	1-105
Gierset, U.S. Application No. 08/335,461:	1, 2, 4-20 and 23

The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Roth, U.S. Patent No. 5,747,469:	None
Gierset, U.S. Application No. 08/335,461:	None

**Part G. Heading to be used on papers**

The heading in SO Form 1 must be used on all papers filed in this interference.

See SO ¶ 7.2.1. The administrative patent judge and parties must be indicated as follows:

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Administrative Patent Judge Michael P. Tierney)

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RUTH A. GIERSET, ROBERT E. SOBOL,  
Junior Party  
(U.S. Application No. 08/335,461),

v.

JACK A. ROTH, TOSHIYOSHI FUJIWARA,  
ELIZABETH A. GRIMM, TAPAS MUKHOPADHYAY,  
WEI-WEI ZHANG, LAURIE B. OWEN-SCHAUB,  
Senior Party  
(U.S. Patent No. 5,747,469).

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Patent Interference No. 105,377  
(Technology Center 1600)

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#### **Part H. Order form for requesting file copies**

When requesting copies of files, use of SO Form 4 will greatly expedite processing of the request. Please attach a copy of Part E of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.

#### **Part I. Required paragraph for affidavits and declarations**

The Board has recently experienced a rash of cases in which a witness has belatedly advanced reasons why he or she would be unable to appear for cross examination at a reasonable time and place in the United States. Consequently, the Board is requiring the following paragraph to be included on the signature page of all affidavits (including declarations) filed in this case to prevent surprise and hardship to the party relying on the testimony of the witness:

In signing this affidavit/declaration, I recognize that the affidavit/declaration will be filed as evidence in a contested case before the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. I also recognize that I may be subject to cross examination in the case and that cross examination will take place within the United States. If cross examination is required of me, I will appear for cross examination within the United States during the time allotted for cross examination.



Enc:<sup>3</sup>

- (1) Copy of STANDING ORDER
- (2) Copy U.S. Patent 5,747,469
- (3) Copy of claims of U.S. Application 08/335,461
- (4) Copy of default time for taking action
- (5) Copy of procedures regarding electronic filing
- (6) Copy of procedures regarding DVD pilot project

Revised January 2005

cc (via overnight delivery):

Counsel for GIERSET:

PERKINS COIE, LLP  
1620 26<sup>th</sup> Street, 6<sup>th</sup> Floor, South Tower  
Santa Monica, CA 90404-4013

Counsel for ROTH:

Thomas D. Paul, Esq.  
FULBRIGHT & JAWORSKI LLP  
1301 McKinney, Suite 5100  
Houston, TX 77010-3095

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<sup>3</sup>No PTO-850 is included.